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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/937,592	09/27/2001	John Gray	MCI-004.1	2680

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EXAMINER

METZMAIER, DANIEL S

ART UNIT	PAPER NUMBER
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1712

DATE MAILED: 01/07/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/937,592

Applicant(s)

GRAY ET AL.

Examiner

Daniel S. Metzmaier

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1712

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 16 September 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 32-65 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 55-60 is/are allowed.
- 6) ☒ Claim(s) 32-54 and 61-65 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.  
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

### **DETAILED ACTION**

Claims 31-65 are pending.

#### ***Claim interpretation***

1. Applicants have amended the claims to insert an intended use (see MPEP 2111.02) and by incorporating the characterization of the products as being cold mixable into a separately prepared liquid aqueous formulation containing at least one principal surfactant. Said proviso statement is interpreted as a functional property of the emulsion and said cold water mixing statement does not set forth the results of the cold water mixing. The specification at page 7, lines 18 et seq; sets forth mixing but does not define the result of said mixing.

Some of the instant claims are drafted in product-by-process format. It is noted, "product-by-process claims are not limited to the manipulations of the recited steps, only the structure implied by the steps". Attention is directed to MPEP 2113 and cited case law therein.

Furthermore, a rejection under 35 USC 102/103 can be made wherein the product claimed appears to be identical to products disclosed in the prior art, wherein the prior art is silent regarding characteristics of said products appearing inherent. See MPEP 2112 and cited case law therein.

Applicants (page 2, lines 1-3; and page 7, lines 17-21) define "cold mixing": "cold-mixable, i.e., desirably mixed into liquid formulations at ambient room temperature without requiring heating.". Ambient temperature is set forth as 0° C to about 30° C.

The phrase, "up to" reads on zero as part of the range. See *In re Mochel*, 470 F.2d 638, 176 USPQ 194 (CCPA 1974).

The solids content would include all components, which are not volatile at ambient temperature, ie, surfactants, salts, fatty oils, polymers, etc..

***Claim Rejections - 35 USC § 102***

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

5. Claims 32-36, 38-43, 45 and 49-54 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Giret et al, 5,409,640. Giret et al (column 9, line 47; to column 11, line 10; particularly example VII) discloses liquid emulsions containing, inter alia, 3% coconut monoethanolamide. While Giret et al. do not use applicants' nomenclature of "emulsifying surfactant", they do disclose cocoamphoacetate, Na laureth-3 sulfate, etc. (column 10, lines 1-27; and Example VII), and it is well-settled that a reference need not disclose a specific limitation *in haec verba*. See *In re Bode et al.*, 193 USPQ 12, 13; and *Ex parte Novitski*, 26 USPQ 2d 1389.

To the extent that Giret et al differs in the functional language characterizing the emulsion components, said components appear to be the same as those claimed and would have been generally expected to have the same properties. Furthermore, some variation in properties would have been expected for different source materials of the individual components and variation of concentrations taught in the Giret et al reference.

6. Claims 37, 44, 46-48, and 61-65 are rejected under 35 U.S.C. 103(a) as being unpatentable over Giret et al, 5,409,640. Giret et al discloses compositions as set forth in the above anticipation/obviousness rejection and the citations are set forth therein. As to claims 37, 61 and 62 herein, while example VII of Giret et al does not disclose a concentration of coconut monoethanolamide of 5% or above, it would have been obvious to one having ordinary skill in the art at the time of applicants' invention was made to use such concentrations in the compositions of Giret et al because they suggest this in column 5, lines 53-59. As to claims 44 and 46-48 herein, while the

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cleansing compositions of example VII of Giret et al does not contain a betaine, it would have been obvious to one having ordinary skill in the art at the time of applicants' invention was made to incorporate a betaine, such as coco- or lauryl-amidopropyldimethylcarboxymethyl betaine, in said cleaning compositions of example VII of Giret et al because they suggest doing this in column 2, lines 41-44; column 5, lines 53-56; and column 7, lines 8-23.

As to claims 63 and 64 herein, while Giret et al may not exemplify a terminal step of adjusting solids content to not more than 60% by adding water, it would have been obvious to one having ordinary skill in the art at the time of applicants' invention was made to use such a terminal step in the process of Giret et al because their disclosure in column 9, lines 40-42, suggest such a procedure.

The characterization of the compositions useful in cold mixing processes is not deemed to distinguish the claimed compositions. The claims do not set forth any effect resulting from cold mixing. Compositions that are stable at ambient temperatures would be expected to be mixable ambient temperatures.

### ***Response to Arguments***

1. Applicant's arguments filed September 16, 2003 have been fully considered but they are not persuasive.
2. Applicants (page 12) assert that new claim 65 (directed to a product -by-process should be allowable based on the allowability of the process. Applicants are reminded that; "product-by-process claims are not limited to the manipulations of the recited steps, only the structure implied by the steps". Please see MPEP 2113.

3. It is understood for the record that when applicants (paragraph bridging pages 12 and 13) refer to a liquid form of monoethanolamide, they are referring to monoethanolamide in an emulsion and not liquid monoethanolamide per se.

4. Applicants (page 14) assert the Giret et al reference does not disclose a liquid form of cold mixable monoalkanolamide. This has not been deemed persuasive. The Giret et al reference does not disclose or even suggest compositions other than liquid emulsions wherein the external phase is an aqueous phase expected to be liquid. Furthermore, applicants have proffered no evidence that the Giret et al compositions are anything other than liquid emulsions. The remaining elements of the claims are disclosed or at least suggested in the Giret et al reference. Applicants' functional language has not been shown to distinguish the instant claims over the Giret et al reference.

Applicants further assert Giret et al does not even teach a cold mixing process and the incorporation of a normally solid monoalkanolamide in aqueous liquid form useful in said process. Applicants' intended use and cold mixing process do not distinguish the compositions, which otherwise read on the claimed compositions or render said composition obvious.

5. Applicants assert the Giret et al reference teaches a multiphase composition having two oil phases and that said product is a finished product rather than products useful in cold mixing process. This has not been deemed persuasive for the following reasons.

It is unclear what teachings applicants base their conclusion that Giret et al teaches multiphase emulsions or two oil phase containing emulsions. Whether the compositions in the prior art are characterized as useful in the exemplified form or in a more diluted form does not distinguish the instant claims since the reference at least suggest dilution at column 9, lines 40-42. Furthermore, dilution is a common practice in formulating and the addition of water to the external phase would not have been expected to significantly affect the emulsion.

Applicants' characterization of the "emulsifying surfactant" has not been found persuasive since it is well settled that a compound and its properties are generally inseparable. Applicants have proffered no evidence that the known emulsifying surfactants disclosed would somehow no longer function as emulsifiers in an emulsifying system of the prior art.

6. It is unclear what applicants base their conclusion (paragraph bridging pages 14 and 15) that Giret et al lacks a teaching of a liquid form of monoethanolamide. Initially, it is understood the emulsion is in liquid form and not the monoethanolamide per se.

Applicants have not shown the cold mixing function of the claims to distinguish the Giret et al reference compositions. See above remarks regarding the cold mixing function wherein said comments have been addressed.

7. Applicants (page 15) assert the "cold mixing" limitation cannot be ignored. Said limitations have not been ignored. In point of fact, said limitation has been addressed, would have been inherent based on the compositions appearing the same and/or been expected based on the disclosure of the Giret et al reference. Giret et al defines



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cleansing emulsions. Emulsions by definition are a liquid dispersed in a liquid. It is unclear where applicants base their conclusion that the Giret et al reference lacks a teaching of liquid compositions.

8. Applicants (page 15) equate the process of making in claim 55 to the products. While a new product or a new starting materials may be evidence of a new process, a new method of using an anticipated or obvious product or a new method of making an anticipated or obvious product would not conversely be evidence of a new product. See MPEP 2116.01; *In re Brouwer*, 77 F.3d 422, 425, 37 USPQ2d 1663, 1666 (Fed. Cir. 1996); *In re Ochiai*, 71 F.3d 1565, 1572, 37 USPQ2d 1127, 1133 (Fed. Cir. 1995).

9. Applicants (page 16) reassert the arguments regarding the anticipation rejection for the claims rejected under 35 USC 103(a). These arguments have been addressed above.

10. Applicants (pages 16 and 17) assert the Giret et al reference do not disclose or suggest all the limitations of the claims. This has been addressed in the rejections and in the above response to applicants' remarks.

11. Applicants (page 17) assert the Giret et al combination of elements does not suggest the formation of a cold mixable liquid aqueous combination claimed. This has not been deemed persuasive and has been addressed above. It is unclear what applicants are required to pick and choose when example VII discloses a liquid emulsion composition of monoethanolamide.

**Conclusion**

12. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Daniel S. Metzmaier whose telephone number is (703) 308-0451. The examiner can normally be reached on 9:00 AM to 5:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vasu Jagannathan can be reached on (571) 272-1119. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (571) 272-1089.



**Daniel S. Metzmaier**  
**Primary Examiner**  
**Art Unit 1712**

DSM